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EXAMINER

MITCHELL, JASON D

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NORMAN H. COHEN, APRATIM PURAKAYASTHA,
LUKE WONG, and DANNY L. YEH

Appeal 2009-007756
Application 10/087,647
Technology Center 2100

Before JAY P. LUCAS, JOHN A. JEFFERY, and JAMES R. HUGHES,
Administrative Patent Judges.

JEFFERY, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-25. The Examiner, however, rejects these claims in the Answer under new grounds. Ans. 2. We have jurisdiction under 35 U.S.C. § 6(b). We dismiss.

STATEMENT OF THE CASE

Appellants' invention rebinds a binding expression to an appropriate network resource according to the changes in the network resources' requirements and the currently-bound resource's properties. *See generally* Abstract.

THE REJECTIONS

1. The Examiner newly rejects claims 1-21 and 24 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Ans. 3-4.
2. Claims 1-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Marshall. Ans. 4-10.¹
3. The Examiner newly rejects claims 22-25 under 35 U.S.C. § 103 as being unpatentable over Marshall and Official Notice. Ans. 10.

PRINCIPLES OF LAW

Section 41.39(b) of Title 37 of the Code of Federal Regulation states:

If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) *Reopen prosecution*. Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will

¹ Throughout this opinion, we refer to (1) the Appeal Brief filed July 30, 2007 and (2) the Examiner's Answer mailed November 14, 2008.

be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

ANALYSIS

Based on the record before us, we must dismiss this appeal. The Examiner prominently identifies the §§ 101 and 103 rejections as new grounds of rejection (Ans. 2)—new rejections that were approved by the Technology Center Director. Ans. 25. The Examiner also unambiguously explained that Appellants *must* exercise one of two options within two months to avoid dismissal of the appeal as to the claims subject to the new ground of rejection. Ans. 24. These regulatory options were: (1) reopen prosecution by filing a reply under 37 C.F.R. § 111, or (2) maintain the appeal by filing a Reply Brief as set forth in 37 C.F.R. § 41.41. *See* 37 C.F.R. § 41.39(b). Appellants, however, chose neither option. The Office has received neither a Reply Brief nor a reply under 37 C.F.R. § 111.

We therefore find that Appellants have failed to avoid dismissal of the appeal as to claims 1-25, which are the claims subject to the new grounds of rejection. *See* 37 C.F.R. § 41.39(b). Since all pending claims 1-25 have been newly rejected under §§ 101 or 103, and Appellants have not responded to these new grounds, dismissal is appropriate.

CONCLUSION

We dismiss the appeal as to claims 1-25, all of which are subject to new grounds of rejection.

The examiner must: (1) cancel claims 1-25, and (2) notify Appellants that those claims are cancelled because the appeal is dismissed. *See* Manual of Patent Examining Procedure (MPEP) § 1207.03(V)(C), Rev. 8, July 2010.

ORDER

The Examiner's decision rejecting claims 1-25 is dismissed.

DISMISSED

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